

### **REMARKS**

Upon entry of the foregoing amendments, claims 1-32 are pending, remain in the application, and are presented for reconsideration. The amendment to the claims do not present any new matter. Applicants attach hereto a version of the claims showing changes made by the current amendment.

The specification at page 21 has been amended to correct a minor spelling error. Claims 1, 18, and 32 have been rewritten to clarify that the layer may comprise one or more fluorophores and to specify that the fluorophores are copolymerized with the polymer composition. Support for these changes specifically may be found in the specification on page 12, line 21 through page 13, line 8; page 18, lines 2-22, and in the examples. Claim 32 also has been rewritten to indicate that the layer comprises a polymer composition. Support for this change may be found in claim 4 as originally filed.

Claims 7 and 24 has been rewritten to delete non-polymeric waxes from the Markush group and to make the scope of the claim consistent with that of claim 1. Claim 10 has been rewritten to place the claim in proper Markush form. Support for this change may be found in the specification on page 6, lines 4-5.

#### **Rejection of Claims 1, 2, 6-11, 18, 19, 23-28, and 32 under 35 U.S.C. §102(e)**

Claims 1, 2, 6-11, 18, 19, 23-28, and 32 have been rejected under 35 U.S.C. §102(e) as allegedly anticipated by U.S. Patent No. 6,682,810 to Jones et al ("Jones"). Applicant respectfully traverses the rejection and the statements made in support thereof.

The reference cited by the Examiner, Jones, discloses a method for forming a coated substrate and for measuring the thickness of a coating, comprising mixing a coating component and a fluorescent component, depositing the coating component on to a substrate; exciting the coating to fluoresce; detecting resultant fluorescence from the coating; and processing the detected fluorescence to determine the thickness of the coating. The coated substrate is prepared by mixing the fluorophore with the coating component and coating that mixture on to a substrate (col. 4, lines 57-61). Jones does

not teach or suggest using a fluorophore that is copolymerized with a polymer composition as is now claimed in the present invention. Applicant believes, therefore, that the current amendment to the claims distinguishes the present invention from the disclosure of Jones and overcomes the rejection under 35 U.S.C. §102(e). Accordingly, Applicant respectfully requests that the rejection be withdrawn.

Rejection of Claims 3-5, 12-17, 20-22, and 29-31 under 35 U.S.C. §103(a)

The Examiner has rejected claims 3-5, 12-17, 20-22, and 29-31 under 35 U.S.C. §103(a) as allegedly obviously in view of the disclosure of U.S. Patent No. 6,682,810 to Jones et al ("Jones") in view of U.S. Patent No. 4,919,855 to Thomas ("Thomas"). Applicant respectfully traverses the rejection and the statements made in support thereof for the reasons stated below.

As the Examiner is aware, a proper analysis under §103 requires, *inter alia*, consideration of whether the prior art would have taught or suggested to one of ordinary skill in the art both that they should carry out the claimed invention and that there is a reasonable expectation of success in doing so. See In re Vaeck, 20 USPQ2d 1438 (Fed. Cir. 1991). Further, the motivation to combine the cited references must be found in the prior art. *Id.* The prior art must teach or suggest all of the claim limitations. See In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). As set forth below, neither the required teaching of the invention, the motivation to combine references, nor the expectation of success is found in the cited art.

The primary reference cited by the Examiner, Jones, discloses a method for forming a coated substrate and for measuring the thickness of a coating, comprising mixing a coating component and a fluorescent component; depositing the coating component on to a substrate; exciting the coating to fluoresce; detecting resultant fluorescence from the coating; and processing the detected fluorescence to determine the thickness of the coating. Jones is directed primarily to measuring the thickness of coating layers which have been deposited on a substrate, such as, for example, a polyester sheet; there is no disclosure regarding measuring the thickness of a

coextruded layers such as, for example, the layers of a multilayered container. Further, as noted previously, Jones only discloses mixing the fluorophore with the coating component and does not teach or suggest using a copolymerized fluorophore as is now recited in Applicant's method. Thus, Jones makes no mention of copolymerization as a method of incorporating the fluorophore into a coating or of the benefits that a copolymerized fluorophore might bring to the method such as, for example, to provide a uniform distribution of the fluorophore within the layer, improved solubility of the fluorophore within the polymer, low extractability, low diffusion, etc. With this omission, Applicant respectfully submits that Jones could not have taught or suggested the method of the instant invention. As noted by the Examiner, Jones also does not disclose the coated article in the form of a preform, a container, or that the layer may comprise a polyamide or barrier enhancing compounds.

The disclosure of Thomas fails to remedy the shortcomings of Jones. In contrast to Jones, Thomas describes a method for the production of a coextruded laminate of a thermoplastic material in which one of the layers of the laminate contains a fluorescing, phosphorescing, or luminescing substance which enables that layer to be recognizable by physical or chemical means. Thomas is completely silent about coated objects and is concerned only with multilayered objects produced by coextrusion. The disclosure of Thomas is notable in that it describes the use of the above light-emitting substances only for the detection of certain layers and not as means to measure the thickness of the layer. For example, Thomas does not mention measuring a fluorescent signal to determine the thickness of the layer. Apart from establishing the presence of a layer, Thomas discloses nothing on the use of fluorophores to measure the thickness of a polymer layer and makes no suggestion of the possibility or desirability of doing so. As in the disclosure of Jones, Thomas neither mentions the use of copolymerized fluorophores nor hints at the feasibility or advantages of such.

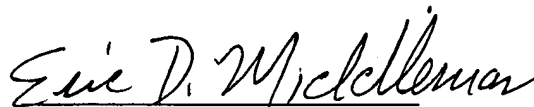
For the reasons discussed above and in view of the current amendment, Applicant respectfully submits that the stated rejection fails to establish a *prima facie* case of obviousness. First, the cited art would not have suggested or motivated the skilled artisan to combine references that teach the invention alleged to be obvious.

Here there is no proper motivation to combine the disclosures of Jones and Thomas as Jones is directed toward measuring the thickness of a deposited coating while Thomas is concerned only with detecting the presence of a coextruded layer. Because, Jones is silent on coextruded layers and Thomas is silent on coatings, a person of ordinary skill in the art would find no motivation within either disclosure to apply the method of one to that of the other. In addition, because Thomas is concerned only with detecting and not with measuring thickness, Applicant respectfully submits that the motivation cited by the Office Action, "in order to more easily measure the thickness of the layers in the container taught by Thomas" (page 3 at 5), cannot be correct.

Second, the cited art, considered either individually or in any reasonable combination, would not have taught or suggested Applicant's method. As noted above, neither Jones nor Thomas recite a using a copolymerized fluorophore. Finally, because the cited art does not provide the requisite suggestion to make the invention and does not in fact teach or suggest all limitations of the presently claimed invention, the cited art necessarily lacks any expectation that the allegedly obvious process would succeed.

Applicants respectfully maintain that Claims 1-32, as amended, are patentable over the cited art, whether considered alone or in any reasonable combination. Applicants, therefore, respectfully submit that the rejection is in error and should be withdrawn. Accordingly, entry of the above amendment, withdrawal of all the rejections, and allowance of the application are earnestly requested.

Respectfully submitted,



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January 26, 2005  
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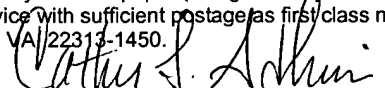
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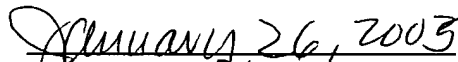
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PATENT

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I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

  
Cathy L. Adkins

  
Date